



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,153	02/13/2007	Magnus Bjork	HALBI 3.3-228	1882
530 7590 04/29/2010 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090				
EXAMINER SMITH, BENJAMIN J				
ART UNIT		PAPER NUMBER		
2176				
MAIL DATE		DELIVERY MODE		
04/29/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/581,153

Applicant(s)

BJORK, MAGNUS

Examiner

Benjamin J. Smith

Art Unit

2176

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 April 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
 Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1, 3-11 and 15-17.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

/DOUG HUTTON/
Supervisory Patent Examiner, Art Unit 2176

/Benjamin J. Smith/
Examiner, Art Unit 2176

Continuation of 11, does NOT place the application in condition for allowance because: The claims would be rejected using the same prior art and the same reasoning as disclosed in the final rejection.

In response to applicant's arguments it should first be noted that the applicant's definition of a "first" and "second" "information entity" that has been incorporated into the claims is not part of the definition in the original specification. The original specification does not contain any link to the first" and "second" "information entity" being a "digital copy" and "overlay", respectively. The applicant fails to make this connection in the specification, the only mention of the first" and "second" "information entity" is in the abstract, fig. 5 and page 14 line 28 thru page 15 line 8 or ¶ 0078 of the publication. Thus it would have not been obvious to one of ordinary skill in the art what the first" and "second" "information entity" are referring to and how they are correlated to the "digital copy" and "overlay" in the other parts of the specification.

The applicant also argues that Patterson is generally related to converting electronic handwritten information to electronic forms and that Patterson fails to disclose a "digital copy of a physical form" (claims 1 and 8) and that the information is preprinted onto the form. The examiner disagrees with this interpretation. Although Patterson is generally directed toward the display of electronic handwritten information on electronic forms, Patterson most defiantly discloses relating a "digital copy of a physical form". Patterson discloses the storing of position information for forms; this position information may be related to the position of a digital form or also a physical form.

"The allocation program 14 assigns a minute subset of the entire coordinate space of the position code to any particular document. The document may comprise, for example, a blank piece of paper; a collection of blank pieces of paper such as, for example, a book or a brochure; or a preprinted form" [Patterson: ¶ 0020] or "associate an overlay with an existing paper form" [Patterson: ¶ 0033]. The "preprinted form" is a "physical form" and the position information may be associated with any form, electronic or physical. This is further shown in the fact that the recorded information associated with the position and the form may be printed in physical form.

The applicant also argues that "Patterson does not teach an overlay that is filled out by the user at all" [response: pg. 7 last paragraph] The examiner would first like to point out that this is not what is claimed in the claims, the claims state "to provide user-generated information provided by a user of the communication terminal to the second information entity" (claim 1 and 8). Although this could mean "an overlay that is filled out by the user" it does not necessarily mean that. This could mean any information generated by a user; this would include markings on the document, a signature, or simply making a selection of a presented option. Patterson most defiantly discloses this, as stated by the applicant "Patterson teaches an electronic form that may be filled out by hand by a user using a digital input device" [response: pg. 7, first full paragraph]